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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
BEFORE THE HONORABLE JAMES WARE

INFORMATION TECHNOLOGIES, INC., a)
Delaware corporation,)
)
Plaintiff/Counterclaim Defendant,)
)
VS.) No. C 08-04990 JW
)
RESEARCH IN MOTION Limited, a)
Canadian corporation,)
)
AND)
)
RESEARCH IN MOTION CORPORATION, a)
Delaware corporation,)
)
Defendants/) San Francisco, California
Counterclaim Plaintiffs.) Monday
) March 12, 2012

TRANSCRIPT OF PROCEEDINGS

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(Appearances continued on next page)

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P R O C E E D I N G S

MARCH 12, 2012

9:24 A.M.

THE CLERK: Calling case C 08-4990, Mformation Technologies versus Research In Motion Limited.

Counsel, please approach and state your name for the record.

MR. THAKUR: Amar Thakur and Justin Gray for Mformation Technologies, Inc.

MR. COHEN: Good morning, Your Honor. Mark Cohen. With me today is Linda DeBruin, whom you've met, Meredith Zinanni, Mike Karson. And then from Research In Motion we have Barbara Parvis, Tony Kim, and Frank Geng.

We did hand up some materials, but I notice we have additional people here. And I have extra materials if you would like --

THE COURT: Give them to the clerk. She will make sure they are distributed in a way that might assist the Court.

THE CLERK: They only need the two.

MR. COHEN: Ms. DeBruin will be handling the argument today.

MR. THAKUR: Your Honor, do you have a preference from which side you hear from first?

THE COURT: Well, it's always my preference to hear first from the owner of the patent with respect to language of

1 the claim itself.

2 **MR. THAKUR:** Your Honor, brought a handful of slides
3 that hopefully help us go through our argument.

4 So, first of all, let's talk about where we stand
5 today. What is the issue? The issue is interpretation of the
6 claim term "establishing a connection between the wireless
7 device and the server."

8 Clearly, based upon preceding language the issue is
9 that the server establish the connection. Not an issue in
10 dispute.

11 All communications have to be done pursuant to using
12 a communication protocol. And that was part of the discussion
13 this court already entertained when entertaining RIM's motion
14 for summary judgment of non- --

15 **THE COURT:** I'm sorry, I missed that middle party.

16 **MR. THAKUR:** I'm sorry.

17 RIM had previously filed a motion for summary
18 judgment of non-infringement. And the Court interpreted, at
19 that point, the fact that the UDP protocol, which is a
20 communication protocol, could not be excluded as a matter of
21 law.

22 And the point I would make, Your Honor, is that a
23 communication protocol has to be used. And to send data there
24 are various different communication protocols, such as UDP and
25 TCP. And so we were just saying the -- the only additional

1 language that we added was that the server establishes a
2 connection, but it does so using a communication protocol.
3 Just to clarify that there are more than -- there's more than
4 one way of establishing the connection.

5 **THE COURT:** All right. Now, is there a difference
6 between -- because these are protocols. I'm not totally
7 familiar with them. Is there a difference between the
8 establishing of connection step and the transmission step?

9 **MR. THAKUR:** Of course there is, Your Honor.

10 **THE COURT:** And are the protocols all exclusively
11 establishing a connection step and not the transmission step?

12 **MR. THAKUR:** Correct. Because you select a protocol,
13 or whatever protocol you selected it would be the analogous of
14 whether you decide to send via FedEx or UPS. The transmission
15 is not relevant to the sending portion, establishing the
16 connection portion.

17 The communication protocol is basically determining,
18 if you will, the analogy of which vendor is going to be used to
19 send out the data.

20 **THE COURT:** So using that analogy, then, the choice
21 of vendors --

22 **MR. THAKUR:** Correct.

23 **THE COURT:** -- does it connect?

24 **MR. THAKUR:** The question, yes, is yes. Once you
25 have chosen the vendor, you know which way it's going to go.

1 **THE COURT:** Yes. But has it connected?

2 **MR. THAKUR:** No. That's -- Your Honor, you've
3 actually hit the key point. The issue is not establishing the
4 connection and transmitting. Those are two different steps.
5 But the connection does not need to occur before --
6 establishing the connection does not need to occur before
7 transmission can begin.

8 There are three steps. Your Honor, if you want to,
9 perhaps, take a look at Claim 1. The purpose is to deliver the
10 command.

11 **THE COURT:** Wait. Let's get a clear answer to my
12 question.

13 **MR. THAKUR:** Sorry.

14 **THE COURT:** So when you've selected the protocol --

15 **MR. THAKUR:** Correct.

16 **THE COURT:** -- have you connected?

17 **MR. THAKUR:** Not necessarily.

18 **THE COURT:** "No" would be the answer I hear.

19 **MR. THAKUR:** Yes.

20 **THE COURT:** When you say "not necessarily," in other
21 words, you can select a protocol and connect?

22 **MR. THAKUR:** Correct. Because there's certain
23 protocols that you would select the protocol, and pursuant to
24 the protocol you would communicate with the device and, if you
25 will, complete the connection step.

1 **THE COURT:** All right. And that is not transmission?

2 **MR. THAKUR:** That is not transmission. Transmission
3 is the command itself.

4 **THE COURT:** All right. And so there are protocols
5 where you can connect to the wireless device, and there are
6 protocols where you do not connect to the protocol device.

7 **MR. THAKUR:** You're establishing the connection.
8 Eventually you will have to connect.

9 **THE COURT:** So establishing a connection in some
10 instances is different from connecting.

11 **MR. THAKUR:** Correct.

12 Your Honor, I'm going to slip to a slide I think
13 really helps.

14 Here's the issue. We have to deliver the command.
15 The command -- there are three steps to it. There is
16 establishing the connection. The second part is then, again,
17 transferring the data. And the third step is accepting.

18 And one potential embodiment is obviously
19 establishing is finished, transferring is finished, and then
20 accepting occurs. But, clearly, there is no requirement,
21 whatsoever, that those steps -- not only that they be performed
22 in order, but that one step be completed before the other.

23 So if I could just summarize for Your Honor, this is
24 what is the biggest point, if you will, of today's argument.
25 The point of today's argument is not actually our proposed

1 construction; it's actually the deficiency in RIM's proposed
2 construction by adding a limitation.

3 What RIM is saying, with reference to Claim 1, is
4 that the claim steps must be performed in order. But that is
5 confusing. It's not the fact that the steps must be performed
6 in order. They're importing the limitation. The establishing
7 the connection must be complete before starting the -- before
8 starting the transmitting of the content.

9 So what they're saying is the only potential claim --
10 the claim can only operate in the way it's depicted up above.
11 The establishing must be completed; transferring must be
12 completed; and accepting will then follow.

13 **THE COURT:** So let me understand this.

14 You agree that transferring and accepting are in an
15 order. You cannot accept until you transfer.

16 **MR. THAKUR:** Your Honor, actually, the issue before
17 the Court --

18 **THE COURT:** No, no. I'm asking that question.

19 **MR. THAKUR:** Yes. I'm sorry.

20 **THE COURT:** Is that correct?

21 **MR. THAKUR:** The answer is, A, it can occur
22 concurrently, or A following B. So you could have
23 establishing --

24 **THE COURT:** Let me test the concurring.

25 **MR. THAKUR:** Right.

1 **THE COURT:** Before you can accept, something has to
2 be transmitted.

3 **MR. THAKUR:** Correct. But --

4 **THE COURT:** But that the entire transmission doesn't
5 have to be complete before the accepting start step can be
6 performed.

7 **MR. THAKUR:** That is absolutely correct.

8 **THE COURT:** All right. But your argument is that
9 unlike those two sub-steps, with respect to establishing a
10 connection it does not have to start prior to the commencement
11 of the transmission step.

12 **MR. THAKUR:** Your Honor, you are hitting the issue
13 spot on.

14 **THE COURT:** I'm asking a question.

15 **MR. THAKUR:** The issue is absolutely yes, it has to
16 start. It does not have to finish.

17 **THE COURT:** So the establishing step has to commence
18 before the transferring step commences.

19 **MR. THAKUR:** Before or concurrently with.

20 **THE COURT:** So the establishing step can start, and
21 the transmitting step can start simultaneously.

22 **MR. THAKUR:** Correct.

23 **THE COURT:** Where does the specification tell me
24 that?

25 **MR. THAKUR:** Your Honor, so, the specification says

1 these steps must occur.

2 From the claim itself, if I may point you to where
3 the Claim 1 is, it says, "delivering the command from the
4 mailbox at the server to the wireless device by establishing a
5 connection."

6 Clearly, the word there is "establishing." It
7 doesn't say, establish a connection would then do Y.

8 What I'm arguing, Your Honor, is if the Court
9 wanted -- if Mformation wanted to limit the claim to step A
10 being followed by step B, but more importantly step A,
11 establishing, being completed before step B can begin, which is
12 transmitting, it would have said so. It would have said,
13 complete the connection and then transmit. The claims did not
14 say that.

15 **THE COURT:** Now, the inventors used the word
16 "establishing" earlier, in establishing a mailbox.

17 **MR. THAKUR:** Correct.

18 **THE COURT:** Does it have the same meaning?

19 **MR. THAKUR:** It has the same meaning, correct.

20 **THE COURT:** So that, is establishing a mailbox
21 something that is ongoing? Or does it happen, and once it
22 happens it doesn't happen again?

23 **MR. THAKUR:** Well, once the step is complete, it's
24 completed.

25 **THE COURT:** All right. And with respect to the

1 delivering step, though, that is a dynamic process; and it has
2 a different meaning, doesn't it?

3 **MR. THAKUR:** Absolutely. I mean, the delivering
4 process is the process of taking the command from the mailbox
5 and delivering it to the device for acceptance. And that
6 requires three sub-steps, and were clearly written as three
7 sub-steps.

8 But nowhere in the claim did it say that sub-step has
9 to be completed before sub-step 2 can begin, that has to be
10 completed before sub-step 3 can begin.

11 **THE COURT:** The point that I'm asking your
12 clarification is, why should I construe it as simultaneous?

13 **MR. THAKUR:** The beginning of.

14 **THE COURT:** I know. But why -- how can I get to an
15 understanding of the inventor conceiving of that sub-step or
16 writing that that sub-step can start simultaneously with the
17 transmitting sub-step?

18 **MR. THAKUR:** Because the patent claim, the '917
19 claim -- and I can cite to the column -- refers to various
20 communication protocols. And different communication protocols
21 deal with those steps being performed in a different order.
22 And even within the protocols, some alternatives exist where
23 within a particular protocol the step will be -- the connection
24 will be established then transmission will begin.

25 Other protocols will start the transmission process

1 and will start -- the delivery process by starting a connection
2 process --

3 **THE COURT:** What you're inviting me to do is turn to
4 those with skill in the art and take from what is written in
5 the specification a protocol where the establishing a
6 connection step is performed simultaneously with the
7 transmission step.

8 **MR. THAKUR:** The answer, Your Honor -- the ideal
9 answer is to not really address the issue of whether it must be
10 simultaneously, but address the issue of whether -- Your Honor,
11 I think what I'm saying is, you're trying to explain fully
12 whether step A must be performed, B must be performed, and A
13 and B must start at the same time.

14 But the issue before the Court is not whether steps A
15 and B must start at the same time. The issue before the Court
16 is whether step A must be completed before step B can begin.

17 **THE COURT:** That's your characterization, but I'm not
18 limiting myself to that. In other words, I understand that
19 point.

20 In fact, I think that, as I've expressed myself in
21 previous opinions, even if you have an order of steps, and that
22 is something that is necessary to the performance of the
23 method, the earlier step must commence before what is ordered
24 to be in the patent, the second step, can commence; but that
25 the first step doesn't have to be completed before the second

1 step is completed.

2 But now you're actually addressing the commencement
3 part, as I understand it. If you want to accept the Court's
4 understanding that the first step has to commence before the
5 second step commences, even if the step is -- first step isn't
6 completed before the second step commences, then I'm done.

7 Are you willing to accept that? I thought you were
8 asking me to construe the second step as starting
9 simultaneously.

10 **MR. THAKUR:** Your Honor, we believe it can start
11 simultaneously.

12 **THE COURT:** That's what I'm searching for. So what I
13 would have to educate myself is, one skilled in the art reading
14 the specification would see a protocol where it can start
15 simultaneously. The order is not important because then there
16 is no order.

17 **MR. THAKUR:** Right.

18 **THE COURT:** They are both performed at the same time.

19 **MR. THAKUR:** They can start at the same time.

20 **THE COURT:** To say "they can start at the same time"
21 means there is no order. They are both number one.

22 **MR. THAKUR:** Right.

23 Your Honor, there is nothing, when you have one, two,
24 three steps, that says you cannot have two items that start at
25 the same time.

1 **THE COURT:** I understand that. What I'm asking is
2 whether or not your position is, one skilled in the art reading
3 this patent would find that there is no order between the
4 establishing step and the transmitting step, that they aren't
5 in any particular order.

6 **MR. THAKUR:** Your Honor, I'm saying -- the
7 interpretation you're asking is much broader. I'm not saying
8 they are not in any order. I'm not saying accepting can occur
9 before transmission.

10 **THE COURT:** No, I'm talking about these two
11 sub-steps --

12 **MR. THAKUR:** Even in those two steps. I'm not
13 arguing that transmitting can begin before establishing can
14 begin. But I --

15 **THE COURT:** I didn't talk about the transmitting step
16 with respect to this order. I'm talking about between
17 establishing and transmitting. Those are the only two
18 sub-steps we are concerned about.

19 **MR. THAKUR:** Right. And I would say, Your Honor,
20 unless the spec limits it to a particular embodiment, where it
21 says A and B must begin at different times, I believe this
22 court does not need to go there because the issue before the
23 hearing today is not whether A needs to begin before B begins.

24 **THE COURT:** All right. Now, so there has to be
25 something -- since we agreed earlier that the transmitting step

1 and the accepting step do have an order, what is it that
2 removes -- that's how I got to this question.

3 **MR. THAKUR:** Right.

4 **THE COURT:** What is it that removes this other
5 sub-step from an order that is evident from the second and the
6 third steps?

7 **MR. THAKUR:** What I think removes it is you can have
8 the -- in a real sense of the world, you can take the command
9 first and start moving it into the pipeline and package it with
10 a protocol that sends the delivery later.

11 If you will, maybe I can use a real-world analogy.
12 I've got a gift to give. I start the gift down the pipeline.
13 But the final decision whether I'm going to put it into a FedEx
14 envelope or a UPS envelope is done later, or can be done
15 essentially as part of that step.

16 **THE COURT:** So what does the inventor mean here by
17 "connection"?

18 **MR. THAKUR:** What the inventor means by a connection,
19 Your Honor, is exactly what I would like to turn to.

20 So here is what we proposed, which is basically
21 communication between -- the server uses a communication
22 protocol to communicate with a wireless device.

23 Your Honor, what RIM has done is proposed to you
24 essentially entirely based on extrinsic evidence. They have
25 one citation to intrinsic evidence, which relates to

1 distribution of software, which is the final software pursuant
2 to CD-ROMs or communication links. That's the actual
3 delivering the software, not the user of the software.

4 So there is no intrinsic evidence that they rely on
5 for communication. What they rely on for a communication link
6 is extrinsic evidence entirely.

7 First, they say -- they talk about a prior court
8 construction: Construing connection is establishing the
9 ability to communicate. They use a handful of definitions,
10 Your Honor: A line of communication between two points. A
11 means of channel. A means of communication.

12 Your Honor, I want to be absolutely clear, we would
13 accept every single one of those definitions that RIM has
14 proposed as secondary, based on technically extrinsic evidence.

15 What they do, however, is take that alternative
16 construction proposal and convert it into a physical link.
17 Remember the physical link is relating to the delivery of the
18 software. Has nothing to do with the mobile device management.

19 **THE COURT:** I appreciate that advocacy causes you to
20 go this way, but I want to hear from the specification because
21 this is claim construction. RIM's out of the picture.

22 **MR. THAKUR:** Right.

23 **THE COURT:** We're back at the point where the patent
24 is being issued.

25 **MR. THAKUR:** Correct.

1 **THE COURT:** And I want to know what one of skill in
2 the art would understand "connection" to be at that point.
3 What does -- what is a connection?

4 **MR. THAKUR:** A means of communication. A method of
5 communication.

6 **THE COURT:** So that if you broadcast, and there is no
7 receipt, you have established a connection within that sense of
8 the word?

9 **MR. THAKUR:** That step, correct, yes.

10 The step of connection just means the ability of
11 communicating. Because in -- in the world of wireless you have
12 push contact and pull contact. Push you just send the
13 information.

14 **THE COURT:** You send it.

15 **MR. THAKUR:** Right.

16 **THE COURT:** And is there a connection when it is
17 sent?

18 **MR. THAKUR:** Yes. That step has been established
19 because the connection -- no, excuse me. Yes. I want to be
20 precise.

21 The establishing the connection involves the idea of
22 identifying the recipient, and either in a push connection
23 sending the package in a way that once it gets to the recipient
24 the recipient will know, I can accept it.

25 **THE COURT:** So that's a broadcast?

1 **MR. THAKUR:** Well, see, the problem is in the
2 communication world "broadcast" actually refers sending stuff
3 that goes to multiple people, instead of unicast.

4 **THE COURT:** But it is a broadcast.

5 **MR. THAKUR:** It's -- the broadcast can be to one
6 person. It can be a unicast, where I am sending the
7 information just to you --

8 **THE COURT:** Let's use unicast.

9 **MR. THAKUR:** Right.

10 **THE COURT:** So a unicast, that is broadcasting to a
11 single recipient.

12 **MR. THAKUR:** Right.

13 **THE COURT:** You would actually define that as
14 establishing a connection with that single recipient?

15 **MR. THAKUR:** Absolutely, correct.

16 **THE COURT:** Why?

17 **MR. THAKUR:** Because the tools for the recipient in a
18 push environment, which is one of the alternative embodiments
19 in the patent claim, you can take the information that I am
20 sending. I want to put the information in so that the
21 recipient -- it can only go to one recipient.

22 **THE COURT:** What if the recipient is off?

23 **MR. THAKUR:** It won't get there.

24 **THE COURT:** Has there been a connection if it's off?

25 **MR. THAKUR:** No, because the connection won't be --

1 establishing the connection will have begun, but the connection
2 will not have been established.

3 That's why it's so important to understand. The step
4 can begin, but the step does not have to finish in particular
5 order.

6 **THE COURT:** Well, but when is the step complete?

7 **MR. THAKUR:** The step is complete when that
8 connection is established, which is when the device knows that,
9 I'm now getting the transmission.

10 **THE COURT:** I'm finally kind of getting there. So
11 you would have "establishing a connection" construed to not
12 require an actual connection?

13 **MR. THAKUR:** I would require the connection not be
14 completed. The steps to the connection, the first part of the
15 connection is sending the -- identifying the person you're
16 going to send it to, and starting the packaging of a
17 communication protocol to send it.

18 **THE COURT:** I didn't get a yes or no. Let me try it
19 again.

20 Would you have the Court define "establishing a
21 connection" in a way does not require an actual connection?

22 **MR. THAKUR:** Correct, but before the steps are
23 completed.

24 **THE COURT:** Very well.

25 **MR. THAKUR:** Your Honor, I would like to save a

1 couple of minutes before I -- just for a rebuttal.

2 **THE COURT:** You have. I've interrupted you.

3 **MR. THAKUR:** No, no, no. I think -- I think I've
4 essentially gotten to my argument, which is, in fact, this
5 court has already given me what I, frankly, think I came here
6 to ask for, which is that the step A need not be completed
7 before step B begins.

8 **THE COURT:** I haven't given you that.

9 **MR. THAKUR:** No.

10 **THE COURT:** I've given you a chance to argue that.

11 **MR. THAKUR:** I would say if it just simply is whether
12 the steps have to be performed in order, Your Honor, I believe
13 that's something this court does not need to address. That's
14 what I was going to say.

15 One last point I want to make, Your Honor, is a lot
16 of reliance by opposing counsel on what arguments I made during
17 claim construction on a prior hearing. And I just want to
18 again emphasize, those points that I made during prior oral
19 argument are in regards to a threshold condition. They talked
20 about steps being performed in the order.

21 Two points on that one. I never said step A has to
22 be completed before step B begins.

23 **THE COURT:** Don't worry.

24 **MR. THAKUR:** Thank you.

25 **THE COURT:** Counsel.

1 **MS. DeBRUIN:** Good morning, Your Honor. Linda
2 DeBruin on behalf of Research In Motion.

3 We're looking at the claim language "establishing a
4 connection between the wireless device and the server." I
5 underlined that language in the claim.

6 I would like to, first, talk about RIM's
7 construction. RIM's construction tracks the claim language and
8 is supported by the intrinsic and extrinsic evidence. I would
9 like to take it piece by piece.

10 First, "establishing." The Court has already
11 construed what establishing meant, and has talked about
12 establishing meaning to bring into existence or set up. We've
13 adopted the term "set up."

14 Next slide, please.

15 Even Mr. Thakur, at the last claim construction
16 hearing, when he was talking about establishing a connection,
17 said a pipe is set up. He used the setup language.

18 There shouldn't be any dispute about "establishing"
19 meaning that. What we need to talk about is what is being set
20 up. A connection is being set up.

21 That is not hiring the vendor or deciding what vendor
22 to use, in Mr. Thakur's terms.

23 **THE COURT:** Why?

24 **MS. DeBRUIN:** That was done by the company that built
25 the system. Whoever built the system that's being used decided

1 what protocol to use.

2 A protocol is just how you're going to do things, how
3 things are going to work, how the steps are going to go.

4 A protocol is not something that you select on the
5 fly in the system. Instead, what is set up here is a
6 connection. And Mr. Thakur, once again, just as he did
7 previously, referred to that as a pipe.

8 What you have to do in establishing the connection is
9 build the pipe. You're going to build the thing over which you
10 are communicating.

11 **THE COURT:** Why? I mean, it just seems to me that
12 limits the word -- if I used 20th century technology, and used
13 a telephone, when I pick up the phone and I get a dial tone and
14 I dial a number, have I established a connection?

15 **MS. DeBRUIN:** Once the person at the other end has
16 answered, once that telephone is picked up, yes, you have, Your
17 Honor.

18 In fact, that's the example --

19 **THE COURT:** That's why I'm bothered by what is
20 required for establishing a connection. Your client would have
21 me construe it to say establishing a connection is only
22 complete when the connection is complete.

23 **MS. DeBRUIN:** Establishing connection is complete
24 when you have set up the connection, when you have set up the
25 pipe, when you have set up, in the terms we used in the

1 claim -- in our proposed language, the communication link.

2 **THE COURT:** Well, my communication link is set up in
3 the telephonic world when a telephone number is assigned to a
4 particular device.

5 **MS. DeBRUIN:** No, it isn't, Your Honor.

6 **THE COURT:** It's not?

7 **MS. DeBRUIN:** Because you need to have your
8 communication link between your phone -- if you're calling our
9 office -- I guess it would usually happen the other way around;
10 we would be calling your office. But if I'm calling your
11 office, then the connection is not set up between us until I
12 call your office and your office answers. Then we have a
13 connection.

14 And the purpose for that connection is so that we can
15 communicate over it. The connection, establishing a
16 connection, is not the communication. The purpose of it is to
17 set it up something so that we may communicate.

18 **THE COURT:** But aren't we -- haven't we set up a
19 connection when I buy a phone, you buy a phone, and we
20 subscribe to a service?

21 **MS. DeBRUIN:** No, we haven't, because there's no
22 connection between my phone and your phone.

23 **THE COURT:** But that's what -- I asked that, and
24 maybe I didn't hear your answer.

25 **MS. DeBRUIN:** Okay.

1 **THE COURT:** Your client would have me construe
2 "establishing a connection" is only complete when the
3 connection has been completed.

4 **MS. DeBRUIN:** When you buy your phone --

5 **THE COURT:** Yes or no to that?

6 **MS. DeBRUIN:** It would be complete when the
7 connection is completed, yes. You would have established the
8 connection when you have the thing established over which
9 you're going to communication.

10 And you're buying a phone --

11 **THE COURT:** You have said it two different ways for
12 me, and I'm trying to make sure I understand what you are
13 saying that sounds different to me, and that is, to set up a
14 telephonic connection doesn't necessarily require a connection;
15 it just requires the ability to connect.

16 But if I were to make a phone call using that system,
17 I could say, well, I haven't connected, you know. But what
18 does it mean to establish a connection? Could be
19 euphemistically referred to as my dialing. It could be
20 subscribing to the system so that we could communicate.

21 There's a continuum of things that could be used by
22 one who would wish to use words to describe this process, this
23 method. So our job is to figure out what this inventor, these
24 inventors, were meaning when they talked about delivering it.
25 And they say one of the sub-steps is establishing a connection.

1 Was there any other place in the patent -- this might
2 be one way to approach it -- where we could define this
3 sub-step because it doesn't exclude -- include something that's
4 already disclosed?

5 **MS. DeBRUIN:** Yes, Your Honor. A couple of places.

6 One, if you look at the language that I have up on
7 the screen, on slide 7, in the patent it describes, upon the
8 connection being established, the commands are transmitted. In
9 other words, after the connection is established, the commands
10 are transmitted. You have to establish a connection before you
11 transmit the commands.

12 And Mformation has argued that the patent describes a
13 broad definition of wireless networks and protocols.

14 Your Honor, that misses the point. That language
15 shows up in the preamble of Claim 1. That language about
16 wireless networks and the protocols that could be used with
17 them is not in the step that we're looking at here of
18 establishing a connection between the wireless device and the
19 server.

20 Now, Mformation, when they first filed their patent
21 application back in August of 2001, they had that broad
22 language about wireless networks in there. They also had an
23 original Claim 1.

24 And I've included in the handout the various pieces
25 from the prosecution history that I'm going to refer to. But

1 in that first version that they had of Claim 1, it didn't
2 require establishing a connection. All that it required was
3 delivering the command from the mailbox to the device.

4 Now, they were not entitled to that claim, the Patent
5 Office determined. And the Patent Office made them add certain
6 language. They had them amend twice to get a claim that was
7 allowed.

8 First, they had to add language requiring that it be
9 without a request from the wireless device. And then they had
10 to add language that showed that you had these three sub-steps
11 for the delivering step.

12 What Mformation is trying to do -- I've put on the
13 board, at slide 14, an orange circle. That's the scope of a
14 wireless network and the protocols that could be used within
15 it, as described in the '917 patent specification. That's what
16 they wrote in August of 2001.

17 But that's not the scope of Claim 1. That's the
18 mistake here, Your Honor. Mformation says that you have to
19 make, somehow, this claim term of establishing a connection
20 match that orange circle, match that scope of this term in the
21 patent.

22 But Claim 1, even as originally filed, had a more
23 narrow scope than that. And its scope got narrower as
24 Mformation had to make amendments to it.

25 What we need to focus on here, Your Honor, is what

1 does "establishing a connection between the wireless device and
2 the server" mean?

3 Mformation wants to equate that with communicating.
4 Now, Mformation's construction is not supported by even the
5 claim language. Mformation's construction doesn't even deal
6 with establishing. Mformation is basically saying that
7 establishing a connection between the wireless device and the
8 server means to communicate.

9 Where in Mformation's construction is there anything
10 about setting up anything? We all agree that establishing
11 means to set up. But there's nothing in Mformation's
12 construction that deals with that. Instead, they refer to
13 using a communication protocol. That happens in any system,
14 any wired system, any wireless system. That's how you
15 communicate. That's just the -- how -- the steps we're going
16 to follow.

17 That adds no meaning to that claim, Your Honor. And
18 what they've done is they basically made a -- they basically
19 are saying "establishing a connection" must mean simply
20 communicating.

21 **THE COURT:** Let me -- you're doing a good job here
22 and I hesitate to interrupt, but I need to have you go to this
23 push protocol.

24 Do you agree that the push protocol can be read by
25 those skilled in the art as covered by this claim?

1 **MS. DeBRUIN:** It could be if you use -- if you use a
2 system in which a connection is established, let's say a TCP
3 connection.

4 **THE COURT:** Well, let me just -- because that "if"
5 bothers me because it seems to me that by putting a condition
6 on it you're saying no, it can't be used, you need some other
7 conditions before push protocol can be used.

8 And so that's why I'm not sure I would agree with
9 you, because one of the things I understand from this patent is
10 that a push protocol was contemplated; that you don't get a
11 request, you just push out to the wireless device. Now --

12 **MS. DeBRUIN:** And I see what you're saying, Your
13 Honor. Let's go back to the slide with the circle.

14 **THE COURT:** Well, but I haven't asked me question
15 yet.

16 **MS. DeBRUIN:** I'm sorry.

17 **THE COURT:** So if you agree that a push protocol can
18 be used, in what sense, as you understand the push protocol,
19 would the establishing a connection sub-step be performed?

20 **MS. DeBRUIN:** If there is a connection established
21 between the entity -- let's say the server -- and the device
22 before the information that's to be sent or pushed is
23 transmitted.

24 A push protocol doesn't really -- by saying the push
25 protocol --

1 **THE COURT:** So the push protocol, as you would have
2 the Court understand it, is not the transfer -- is the
3 transmission step. And the establishing step is not a part of
4 the push protocol.

5 **MS. DeBRUIN:** Well, it's also the setting up the
6 connection. And I have a slide -- actually, let's forget the
7 circle slide and let's go to the slide that -- correct.

8 (Slide displayed.)

9 **MS. DeBRUIN:** What Mformation is doing -- and you
10 raised an interesting point, Your Honor -- Mformation is
11 basically attempting to read out the step of establishing a
12 connection from this patent claim.

13 And I'm going to explain to you why. And this is a
14 really important point.

15 Mformation, when it submitted its patent -- as you
16 know, you're talking about push -- they first sought to have
17 patent claims that covered pull and that covered push. They
18 wanted both. But the Patent Office said, you're not entitled
19 to those claims that cover pull.

20 Patent Office looked to a reference called Lo Vasco.
21 And what Lo Vasco taught was the device establishing a
22 connection, and then the server transmitting over that
23 connection.

24 That's not push, Your Honor. That's pull. The
25 device is setting up the connection, and then the server is

1 using that connection to transmit.

2 That's not covered by Claim 1 because Claim 1
3 requires that the server, not the device, and it requires that
4 by the language, and without a request from the wireless device
5 performing the following steps. And those steps include, after
6 the final amendment of Claim 1, they include establishing a
7 connection.

8 Now, what mischief is Mformation trying to do? Think
9 about that situation, the situation that Mformation was told
10 they weren't permitted to have, which is the device setting up
11 a connection, and then the server and device communicating
12 using that connection.

13 We put that type of arrangement in front of
14 Mformation's expert, Dr. Madisetti. So the device,
15 establishing a connection. But he simply said, oh, that
16 connection, that's not what we're thinking about. That's not
17 what Claim 1 is talking about. Not that connection.

18 The problem with what he did is this. Let's look at
19 our device. Establishing a connection with the server. What
20 Mformation wants to say is when that server uses that pipe
21 that's now set up between that device and the server, when that
22 server uses a communication protocol to communicate with the
23 wireless device, which we have just shown up on slide 22,
24 Mformation says, oh, well, there, that server is setting up a
25 connection.

1 That's what Mformation's claim language says. It
2 says that the server using a communication protocol to
3 communicate with the wireless device is establishing a
4 connection. And they want to say that even if you're doing
5 that over an already established connection.

6 That's exactly what the Patent Office said Mformation
7 was not entitled to have. And that is the reason, Your Honor,
8 that Mformation's construction is not correct.

9 Now, RIM's construction, RIM's construction reflects
10 the patent claim. It's true to the patent claim. It indicates
11 that we established, we set up something. It describes what is
12 being set up. There's various ways that's been described.

13 Mformation's counsel has referred to that as a
14 communication link. There's a treatise from Dr. Tannenbaum, a
15 well-known computer science professor, where he refers to it as
16 a tube. We chose the language from the patent that talked
17 about a communication link being transmission media.

18 But whatever you call it, it's something that's going
19 to be set up in order to communicate over. It's not just
20 selecting a protocol. As I said, that protocol was selected
21 when the system was designed, not during the operation of the
22 system.

23 And you talked with Mr. Thakur about order. Order
24 matters here. Order matters because, first, from a matter of
25 logic, if you're going to use something to communicate over,

1 you have to set it up before you communicate.

2 The specification said that. "Upon connection being
3 established, the commands that were stored in the mailbox are
4 transmitted." First you connect, then you transmit.

5 Dr. Kushwaha, the named inventor of the '917 Patent,
6 said the same thing in his deposition. He said, "You establish
7 the connection based on a threshold condition, and after, after
8 you establish the connection, you send the command.

9 That's what the claim language of Claim 1 requires,
10 Your Honor. Mformation wasn't entitled to just a claim that
11 had just the delivering step. But that's basically what
12 they're trying to revert to here now. But they weren't
13 entitled to that. They had to do that without a request from
14 the wireless device, and they had to perform these three
15 specific sub-steps. One being the one we're talking about
16 here, establishing a connection.

17 **THE COURT:** Well, let's assume I follow that. What
18 is the timing requirement? In other words, this all can happen
19 in a sequence, or it can all happen at once, or it can all
20 happen asynchronistically.

21 What is it that tells me that one has to occur before
22 the other, other than the admission of the inventor here?
23 Because that's extraneous information.

24 **MS. DeBRUIN:** I understand. And what we mainly
25 relied on for that point, Your Honor, is the language from

1 specification: "Upon the connection being established, the
2 commands that were stored in the mailbox are transmitted."

3 That's what it means to establish a connection. You
4 establish a connection, and then after that happens, only after
5 that connection is established, are the commands transmitted.
6 That's what the patent says. And that's the only thing that
7 the patent says.

8 There's no other embodiment described in the patent.
9 The patent doesn't describe any embodiment in which you
10 transmit before you connect, or you connect and transmit at the
11 same time. This is all that the patent describes. And this is
12 the logical way to interpret the patent claim.

13 You're setting up something over which you wish to
14 communicate. You set up the connection, and then you use it to
15 transmit.

16 **THE COURT:** I'm still not sure I understand your
17 argument with respect to the push process.

18 Now, maybe your argument is, push doesn't work for
19 this invention. But I was waiting for you to explain how you
20 reconcile this language with the push protocol, as I understand
21 the push protocol.

22 Maybe I don't understand the push protocol, but it
23 did seem to me that when I looked at it, especially since it's
24 mentioned in the specification, I had to give to the inventors
25 that this could be used in that kind of protocol.

1 **MS. DeBRUIN:** And it could be, Your Honor, but my
2 answer is that not -- just saying push doesn't say whether the
3 claim would cover that protocol or not. And here's why. You
4 could push without establishing connection.

5 The broadcast example that you gave, where you just
6 send something out, you don't know whether it's going to get
7 there or not -- maybe it does, maybe it don't -- that would be
8 pushing information without a connection being established.

9 In fact, that's what RIM does. RIM sends out
10 information. And it doesn't know whether a device is going to
11 be able to receive that or not. It doesn't know whether the
12 device is on. It doesn't know whether the device is somewhere
13 that it can reach, that signal can reach it. But it sends it.
14 And it has other ways of making sure that the communication is
15 reliable. But it doesn't set up a connection.

16 Alternatively, you could have a push arrangement
17 where the first thing you do is the server would establish a
18 connection with the device, and then it pushes information to
19 the device. That would all be done without a request from the
20 wireless device.

21 But what Claim 1 requires -- so to read Claim 1 in an
22 infringement analysis on any kind of protocol, you have to look
23 for a step of establishing a connection and then a step of
24 transmitting. If you don't have the step of establishing a
25 connection, then Claim 1 doesn't apply.

1 **THE COURT:** Now, let me ask -- I see our time is up,
2 but -- can we turn off the red light because we are way out of
3 time here anyway.

4 What I wonder about is the construction that I was
5 discussing with your opponent a moment ago, as to whether or
6 not in steps just in general, if you say that steps have to be
7 performed in an order, does that necessarily mean that step 1
8 has to be completed before step 2 commences? Or are the steps
9 in an order, if step 1 commences, and step 2 commences after
10 step 1 has commenced, without necessity of step 1 having to be
11 completed?

12 **MS. DeBRUIN:** It's hard to say in the abstract, Your
13 Honor. I would say in the case here you need to establish a
14 connection before you use it to communicate over. And the
15 language from the specification says that.

16 **THE COURT:** Well, does the transmitting step require
17 that you transmit over the connection that has been
18 established?

19 **MS. DeBRUIN:** It requires that you transmit using
20 that connection.

21 **THE COURT:** Where does it say that? Where does it
22 say that?

23 **MS. DeBRUIN:** It says, upon connection being
24 established the commands that were stored in the mailbox --

25 **THE COURT:** That's from the specification. The claim

1 says nothing about that "upon"; does it?

2 **MS. DeBRUIN:** That's assumed, Your Honor --

3 **THE COURT:** Right.

4 **MS. DeBRUIN:** -- from establishing a connection.

5 **THE COURT:** The claim language itself doesn't require
6 that whatever we're calling a connection be used for the -- it
7 says, transmitting the content. It doesn't say using the
8 connection that has been established.

9 Now, maybe one skilled in the art would read it that
10 way, but that's not the claim language. Right?

11 **MS. DeBRUIN:** One skilled in the art would understand
12 that that language requires a connection to be set up.

13 Now, we're not saying that an actual physical
14 connection is being set up and the information is going to flow
15 over that physical connection; but, rather, that we establish a
16 connection and then information is going to flow between us
17 using that connection.

18 **THE COURT:** But that's -- again, both sides, it seems
19 to me -- this may be one of those instances where I need the
20 trial, and I need to say to the jury, I haven't come up with a
21 definition of this term yet; or just keep it to myself and give
22 them that definition after I've heard more. Because I'm having
23 difficulty, at this point, in giving a good definition because
24 I need to learn more.

25 Maybe I need to have a separate proceeding, where I

1 have a better tutorial on the various technologies and how they
2 operate. Someone told me there is such a thing as a
3 connectionless connection. I don't understand that at all.

4 **MS. DeBRUIN:** Your Honor, we certainly would be
5 willing to do -- I think it would be useful to have this term
6 construed before trial. And we could make our expert
7 available. I'm sure that Mformation could make their expert
8 available. We could put on a tutorial and talk about this in
9 more detail.

10 **THE COURT:** It does seem to me -- let me have your
11 opponent back.

12 What I would have you address -- and I can anticipate
13 your answer but I want to hear it on this record, of the
14 threshold conditions.

15 The threshold conditions, I've already construed
16 that. But does that factor into whether or not the
17 establishing step is something that is a protocol that is
18 infrastructure oriented? Or is that -- those threshold
19 conditions something that are very dynamic, that happen as part
20 of the delivering step; and, therefore, the establishing step
21 is a dynamic process as opposed to something that is based on
22 some protocol that is already there?

23 **MR. THAKUR:** Your Honor, what I would suggest is -- I
24 think you've clearly grasped -- in my opinion, you've clearly
25 grasped the issue that establishing and transmitting must occur

1 in some sort of order, whether they begin at the same time or
2 whether A must occur. The word there is "establishing a
3 connection." And in fact, even in RIM's slide 7 --

4 **THE COURT:** You didn't answer my question.

5 **MR. THAKUR:** Okay. I guess what I'm saying is, the
6 last step, the establishing begins, the transmitting can begin,
7 but the connection is established. So the completion is based
8 upon a threshold condition.

9 **THE COURT:** All right. Now, just a moment.

10 **MR. THAKUR:** Sorry.

11 **THE COURT:** So tell me your best argument as to the
12 relationship of the wherein step would be establishing.

13 **MR. THAKUR:** The establishing can begin at some
14 point. At some point in the establishing step, there has to be
15 a threshold condition that has been checked. This court had
16 actually construed that. The --

17 **THE COURT:** Just a moment.

18 So you don't believe the threshold conditions have
19 anything to do with the commencement of the establishing?

20 **MR. THAKUR:** With the commencement, correct, because
21 commencement occurs up above. It is the completion.

22 Your Honor, this is the keyword there: establishing.
23 And then the last step is where the connection is established.
24 And I would argue that that almost reaffirms what I've been
25 arguing all along. The step A can begin. Step A is only

1 completed when that occurs, the threshold condition is
2 satisfied.

3 **THE COURT:** So I would have to read the threshold
4 conditions as not conditions which are satisfied when we are
5 establishing a connection. And somehow the inventor
6 contemplates that those threshold conditions come into
7 existence during the process of establishing a connection,
8 without disclosing when that is or how we know it, but
9 completed at the point where the connection is established.

10 **MR. THAKUR:** Correct. The threshold condition
11 evaluation can begin when the connection is being established.
12 And, again, slide 7, RIM's counsel says "upon being
13 established." It doesn't say "upon establishment."

14 **THE COURT:** But what tells the world when those
15 threshold conditions are evaluated?

16 **MR. THAKUR:** Because those threshold conditions can
17 be evaluated -- all of this is occurring, as we said, at the --
18 without a request from the wireless device.

19 So the software package would start the process of
20 evaluating the threshold condition. But the connection cannot
21 be established until the threshold condition is met.

22 **THE COURT:** But we're adding to the claim, at that
23 point. In other words, we're adding to this method --

24 **MR. THAKUR:** Correct.

25 **THE COURT:** -- some process of the threshold

1 conditions coming into existence, which perhaps did exist
2 before the established step.

3 **MR. THAKUR:** Correct.

4 **THE COURT:** And then some evaluation of that before
5 the connection is established.

6 **MR. THAKUR:** Correct. So this must be completed
7 before it can -- the threshold condition must be evaluated
8 before the connection can be completed, not before it can
9 begin.

10 **THE COURT:** Well, let me think about all of this. I
11 really appreciate the effort that has gone into this process.

12 What is your reaction to the Court's notion that
13 maybe this is extrinsic evidence that the Court can take in a
14 separate hearing from the various experts?

15 You've provided me with the technical advisor, so
16 might be listening with a learned ear by my side. I think I
17 might benefit from that.

18 **MR. THAKUR:** Your Honor, we're in our fourth year.
19 We're a small company. The resources they have -- their
20 methodology to date has been, If you fail, try, try again.

21 The answer is, Your Honor, you have a technical
22 expert. The patent says push technology. You have the
23 briefing of the parties. You've heard oral argument. You have
24 two opposing experts say the same thing.

25 **THE COURT:** Where is your expert located?

1 **MR. THAKUR:** Your Honor, he's located in Atlanta. He
2 teaches at Georgia Tech.

3 **THE COURT:** Is there a time when you know when he
4 will be out here in advance of the trial?

5 **MR. THAKUR:** I don't know. I don't --

6 **THE COURT:** Where is your technical expert located?

7 **MS. DeBRUIN:** He's in San Diego, Your Honor.

8 **THE COURT:** Why don't you meet and confer and see
9 whether, without undue expense, there's a time and place -- and
10 get my staff involved -- where that might happen. Do you have
11 a trial date?

12 **MR. THAKUR:** We do, Your Honor.

13 **THE COURT:** What's your trial date?

14 **MR. THAKUR:** June 19th.

15 **THE COURT:** June 19th. So it would surprise me if
16 you don't contemplate having your expert at your disposal
17 between now and June 19th. And so I'm suggesting maybe we
18 could take advantage of that. And if you knew about it well
19 enough ahead of time, we could clear our calendar. Maybe we
20 could take advantage of a time when it wouldn't be an
21 extraordinary expense to your client.

22 But if you tell me no, we can't make that
23 arrangement, I'll take that into consideration, as well. Your
24 argument is, it's clear and you shouldn't need that.

25 **MR. THAKUR:** Honestly, yes, it is clear, Your Honor.

1 This is our third claim construction. And how many
2 summary judgment motions, Your Honor -- I would take a picture
3 of my client -- actually, use RIM's slide 13, and take a look
4 where they show a picture of my client.

5 This is really important, Your Honor. If you switch
6 over to the slide.

7 **THE COURT:** This has your --

8 **MR. THAKUR:** This is their slides, Your Honor.

9 There's a step where they show a picture of my
10 client. I want to say this. Your Honor, if you want to see a
11 picture of someone exhausted, that's a picture of someone
12 exhausted.

13 (Slide displayed.)

14 **THE COURT:** I would say that's determined.

15 **MR. THAKUR:** All I would -- yes.

16 In any case, Your Honor, yes, we will do what this
17 court asks of us. But we implore this court, implore this
18 court, to issue a ruling.

19 **THE COURT:** Where is your client located?

20 **MR. THAKUR:** In New Jersey, Your Honor.

21 **THE COURT:** They chose this venue?

22 **MR. THAKUR:** Your Honor, they did choose this venue.
23 We think it's a good venue. So at least we thought it was a
24 good venue. I say that in jest. We still belief it's a good
25 venue.

1 **THE COURT:** Thank you, all. The matter is submitted.

2 Just one moment.

3 (Pause)

4 **THE COURT:** Thank you. The matter is submitted.

5 **MS. DeBRUIN:** Thank you, Your Honor.

6 **THE CLERK:** All rise.

7 (At 10:19 a.m. the proceedings were adjourned.)

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13 **CERTIFICATE OF REPORTER**

14 I certify that the foregoing is a correct transcript
15 from the record of proceedings in the above-entitled matter.

16
17 DATE: Tuesday, March 13, 2012

18 s/b Katherine Powell Sullivan
19 _____

20 Katherine Powell Sullivan, CSR #5812, RPR, CRR
21 U.S. Court Reporter
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